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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,209	06/04/2001	Neal A. Brown	10431-005001	6091

7590 08/03/2004

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EXAMINER	
SINGH, SUNIL	

ART UNIT	PAPER NUMBER
3673	

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/875,209	BROWN ET AL.
	Examiner	Art Unit
	Sunil Singh	3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1-8, 10-25, 28-32, 34-49* is/are rejected.

7)☒ Claim(s) *9,26,27 and 33* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-4, 10, 13-20, 22-24, 34, 36, 39 and 42-49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,148,751 in view of Pollack (US 6027286).

3. Claims 5-8, 11, 35, 37, 40-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,148,751 in view of Pollack and Smith.

4. Claims 5-6, 8, 11-12, 35, 37-38, 40-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,148,751 in view of Pollack and Brahtz.

5. Claim 21 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,148,751 in view of Pollack and Purcell, Jr. or Payne.

6. Claims 25, 28, 30-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,148,751 in view of Shu et al. and Watson.

7. Claims 25, 28, 30-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,148,751 in view of Pollack and Watson.

8. Claim 29 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,148,751 in view of Shu et al. and Watson and Smith or Brahtz.

9. Claim 29 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,148,751 in view of Pollack and Watson and Smith or Brahtz.

10. Claims 1-4, 10, 13-20, 22-24, 34, 36, 39 and 42-49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No.6,349,664 in view of Pollack

11. Claims 5-8, 11, 35, 37, 40-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,349,664 in view of Pollack and Smith.

12. Claims 5-6, 8, 11-12, 35, 37-38, 40-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,349,664 in view of Pollack and Brahtz.

13. Claim 21 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No.6,349,664 in view of Pollack and Purcell, Jr. or Payne.

14. Claims 25, 28, 30-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,349,664 in view of Shu et al. and Watson.

15. Claims 25, 28, 30-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No. 6,349,664 in view of Pollack and Watson.

16. Claim 29 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No.6,349,664 in view of Shu et al. and Watson and Smith or Brahtz.

17. Claim 29 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of U.S. Patent No.6,349,664 in view of Pollack and Watson and Smith or Brahtz.

Claim Rejections - 35 USC § 102

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

19. Claims 1-4, 10, 34, 36, 39, 42, 46-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Pollack (US 6027286).

Pollack discloses a marine riser comprising a riser pipe (30), an annular sheath (156) surrounding the riser pipe and at least one pair of nozzles (see col. 6 lines 5-12). System (see col. 6 lines 10+) for pumping water through the conduit.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

21. Claims 15-20, 22-24, 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pollack in view of Shu et al. (US 6551029).

Pollack discloses the invention substantially as claimed. However, Pollack lacks a tail jet/fin and a buoyancy ring disposed between the riser pipe and the annular sheat. Shu et al. teaches tail jet/fin (see Fig. 7, col. 6 lines 13-19) and with regards to the buoyancy ring see attached marked up Figure 4. It would have been considered obvious to one of ordinary skill in the art to modify Pollack to include the tail jet/fin and the buoyancy ring as taught by Shu et al. in order to effectively protect the riser from vortex induced vibrations.

22. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pollack.

Pollack discloses the invention substantially as claimed. However, Pollack is silent about his conduit having pipes/ducts therein that connects to his nozzles. It is well

known and old in the art to have a conduit wherein pipes/ducts therein connect to nozzles. It would have been considered obvious to one of ordinary skill in the art to modify Pollack to include pipes/ducts within his conduit since such an arrangement is notoriously old and conventional in connecting pumps to nozzles, wherein the pump is supplying water to the nozzles.

23. Claims 5-8, 11, 35, 37, 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pollack in view of Smith (US 3894504).

Pollack discloses the invention substantially as claimed. However, Pollack is silent about having a rotatable sheath which includes a ring gear, pinion gear and gear motor. Smith teaches a rotatable sheath (24) which includes a ring gear (40), pinion gear (50) and gear motor (42). It would have been considered obvious to one of ordinary skill in the art to modify Pollack to include the rotating means as taught by Smith in order to reduce vortex induced vibration.

24. Claims 5-6, 8, 11-12, 35, 37-38, 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pollack in view of Brahtz (US 3762352).

Pollack discloses the invention substantially as claimed. However, Pollack is silent about having a rotatable sheath which includes a ring gear, gear motor and controller. Brahtz teaches a rotatable sheath (12) which includes a ring gear (14), gear motor (20) and controller (18). It would have been considered obvious to one of ordinary skill in the art to modify Pollack to include the rotating means as taught by Brahtz in order to reduce vortex induced vibration.

25. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pollack in view of Shu et al. as applied to claim 20 above and further in view of Purcell, Jr. or Payne (US 3614032, 3763810).

Pollack (once modified) discloses the invention substantially as claimed. However, the (once modified) Pollack is silent about having a retractable tail. Purcell, Jr. and Payne both teach a retractable tail (42,199). It would have been considered obvious to one of ordinary skill in the art to further modify the (once modified) Pollack to make his tail retractable as taught by either Purcell, Jr. or Payne in order to avoid damage to the tail when not in use.

26. Claims 25, 28, 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shu et al. or Pollack in view of Watson (US 4300855).

Shu et al. and Pollack both disclose the invention substantially as claimed. However, they both are silent about having a telescoping sheath . Watson teaches a telescoping sheath (see Figs. 5, 10). It would have been considered obvious to one of ordinary skill in the art to modify either Shu et al. or Pollack by making their sheath telescoping as taught by Watson in order to be able to use the marine riser in both deep and shallow waters.

With regards to claim 30, the structure is rotatable since the word rotatable means capable of rotating.

With regards to claim 31, the diameter of the cylindrical sections decreases (see Figs. 5 and 10 of Watson).

27. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shu et al. or Pollack in view of Watson as applied to claim 25 above, and further in view of Smith '504 or Brahtz '352.

Shu et al. or Pollack (once modified) discloses the invention substantially as claimed. However, the (once modified) Shu et al. or Pollack is silent about having a rotatable sheath/cylindrical section. Smith and Brahtz both teach rotatable sheath/cylindrical sections (24, 12 respectively). It would have been considered obvious to one of ordinary skill in the art to further modify either of the (once modified) Shu et al. or Pollack to include the rotating means as taught by either Smith or Brahtz in order to reduce vortex induced vibration.

Allowable Subject Matter

28. Claims 9, 26-27 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

29. Applicant's arguments with respect to claims 1, 34, 39 and 46 have been considered but are moot in view of the new ground(s) of rejection.

30. Applicant's arguments filed 1/29/04 have been fully considered but they are not persuasive. Applicant argues that Shu et al. cannot anticipate his claims since his claim to priority (US 6349664, 6148751) predates the Shu et al. reference. The examiner agrees this is true with all independent claims and their respective dependent claims

except claim 25 and its dependent claims. Claim 25 is the continuation in part and thus does not basis in Patents 6349664, 6148751.

Conclusion

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (703) 308-4024. The examiner can normally be reached on Monday through Friday 8:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sunil Singh
Patent Examiner

Art Unit 3673

SS7/28/04

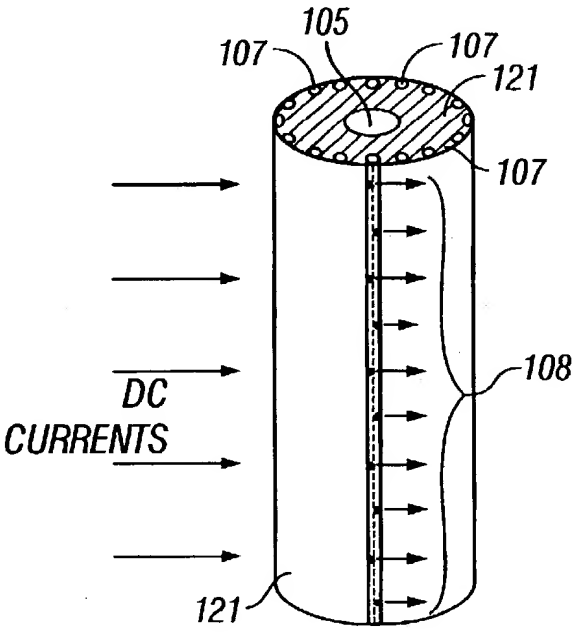
105
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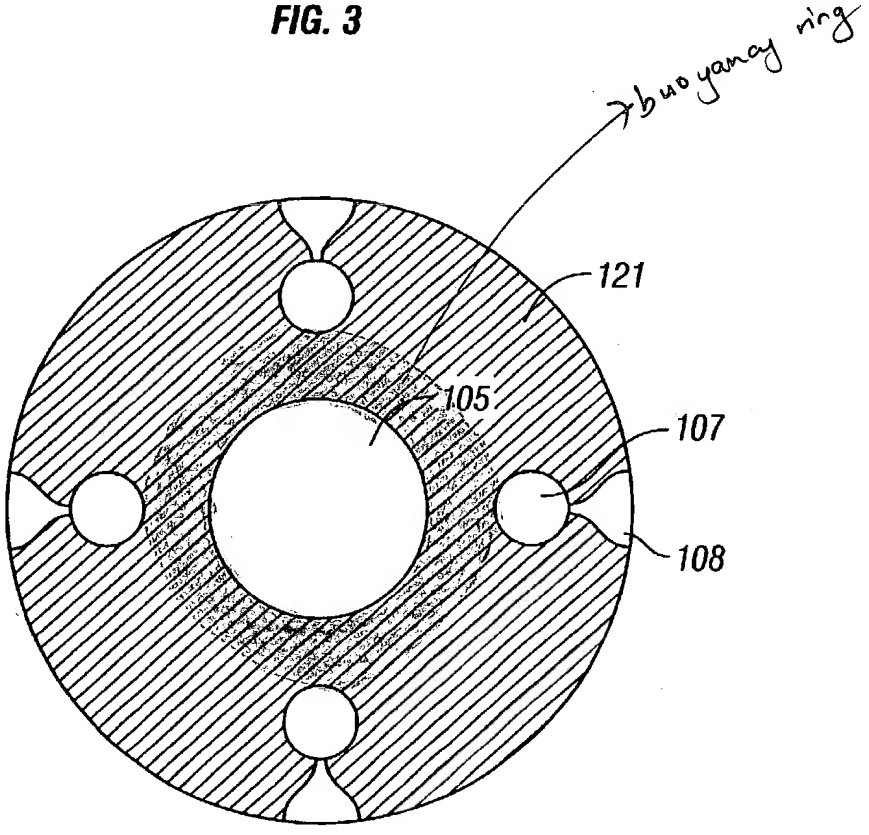
FIG. 3


buoyancy ring
121
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107
108

FIG. 4